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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,388	01/02/2004	Eldad Taub	25306Y	9142

7590 09/29/2005

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EXAMINER

WILSON, JOHN J

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 09/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/749,388

Applicant(s)

TAUB ET AL.

Examiner

John J. Wilson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 27-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sachdeva et al (6350120) in view of Wu et al (5338198). Sachdeva shows a method using a computer to select virtual components including virtual components that represent standard brackets from an electronic library of brackets, column 6, lines 24-35, providing a three dimensional virtual image model, see step 60 in Fig. 4, associating the virtual components with the model, step 64, computing the manner of movement of the teeth, step 74 and column 6, lines 36-59, selecting a component for use, column 7, lines 1-6 and using similar brackets in treatment, column 7, lines 58-67. Sachdeva does not show a model being manipulable so as to allow viewing from a desired direction. Wu teaches electronic models that can be viewed from any perspective, column 1, lines 20-25. It would be obvious to one of ordinary skill in the art to modify Doyle to include the function of allowing the models to be viewed from different directions as shown by Wu in order to make use of a well known computer graphics tool for computer graphics design. Sachdeva also teaches that if tooth movement is not favorable, then the method selects another bracket from the library of digital brackets. This inherently generates a set of brackets, not originally input by the user, and as such, inherently generates a new prescription for treatment. It is held that communication of this newly generated set of components to the user is inherent

and/or obvious in the teaching of Sachdeva, and that such communication inherently comprises a prescription. As to claim 50, when the taught standard brackets of Sachdeva are used, the virtual brackets representing these standard brackets inherently provides a virtual set that simulates real life components. To store rules in a data base and the type of data base used are obvious matters of choice in the use of known storage types to the skilled artisan. To include extracted or restored teeth in the calculations is well known in modeling orthodontic treatment.

Terminal Disclaimer

The Terminal Disclaimer filed July 25, 2005 successfully removes patent 6,739,869 as a reference under double patenting.

Response to Arguments

Applicant's arguments filed September 9, 2005 have been fully considered but they are not persuasive. Applicant's argument that Sachdeva is directed to a comparison of components and not generating a prescription is disagreed with. The comparison of Sachdeva is a step in a method of finding the components that best move the teeth to the desired location as shown by the step that if the comparison is not favorable, then a new virtual bracket is used. The final set of components obtained by the method of Sachdeva inherently comprises a prescription and it is clear from the disclosure of Sachdeva that this information is communicated to the user of the system. Applicant's further argument that Sachdeva does not show generating a prescription after the comparison because a dentist must still write the prescription is disagreed with because this interpretation of the limitation "prescription" is not commensurate with the present disclosure. The communicated information of the final components of Sachdeva inherently

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provides a prescription as reasonably interpreted in view of the present disclosure. Further, having a computer print results is well known to a skilled artisan and would have been an obvious way to communicate the final set of components found by the method. With respect to claim 50, it is held that the teachings of Sachdeva of the use of virtual brackets that represent standard brackets inherently provides a virtual set that simulates real life components.

Conclusion

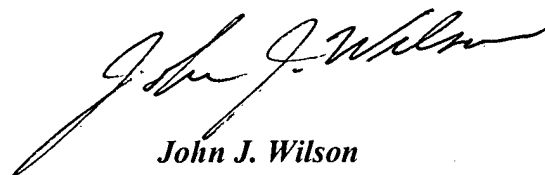
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Wilson whose telephone number is 571-272-4722). The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver, can be reached at 571-272-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "John J. Wilson", with a stylized, sweeping flourish at the end.

John J. Wilson
Primary Examiner
Art Unit 3732

jjw

September 23, 2005